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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,018	04/08/2004	Andrew William McLauchlin	1330.1093D2	7566

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EXAMINER

FILIPCZYK, MARCIN R

ART UNIT	PAPER NUMBER
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2163

DATE MAILED: 11/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/820,018

Applicant(s)

MCLAUCHLIN, ANDREW WILLIAM

Examiner

Marc R. Filipczyk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/8/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Action is responsive to Application filed on April 8, 2004 wherein claims 1-6 are submitted for examination.

To expedite the process of examination Examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. amendments, 35 U.S.C. 112, objections and the like) set forth by the Examiner that Applicants provide and link to the most specific page and line numbers of the disclosure where the best support is found (see 35 U.S.C. 132).

Information Disclosure Statement

The information disclosure statement filed 4/8/04 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has only partially been considered because copies of NPL have not been provided.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitations of **“enabling interoperability among the application systems using the baseline data schema”** and **“providing access to the application systems via the point of access using the application database and the reporting database”** must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing

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sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: In paragraph [34], the label for EAI tool 36 should be changed to "70" according to the drawings. All other related corrections should be corrected.

Appropriate correction is required.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-6 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 7-12 of copending Application No. 10/820,017 (supplemental claims submitted in preliminary amendment on 5/24/2004). This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim 1 is provisionally rejected under 35 U.S.C 101 as claiming the same invention as that of claim 7.

Claim 2 is provisionally rejected under 35 U.S.C 101 as claiming the same invention as that of claim 8.

Claim 3 is provisionally rejected under 35 U.S.C 101 as claiming the same invention as that of claim 9.

Claim 4 is provisionally rejected under 35 U.S.C 101 as claiming the same invention as that of claim 10.

Claim 5 is provisionally rejected under 35 U.S.C 101 as claiming the same invention as that of claim 11.

Claim 6 is provisionally rejected under 35 U.S.C 101 as claiming the same invention as that of claim 12.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth whether the invention accomplishes a practical application and whether it generates a useful, concrete and tangible result.

The guidelines explain that a practical application of a 35 U.S.C. 101 judicial exception is claimed if the claimed invention physically transforms an article or physical object to a different state or thing, or if the claimed invention otherwise produces a useful, concrete, and tangible result.

In the present case, independent claims 1 and 4 do not involve transformation of article or physical object to a different state or thing, they merely recite a storage medium. Further, independent claims 1 and 4 do not produce a useful, concrete, and tangible result, but merely provide access. State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02.

Claims 1 and 4 taken as a whole are directed to a system claim, i.e., to only an abstract idea, and do not comprise a practical application as explained above hence are nonstatutory.

Since the claimed invention, as a whole, does not comprise a practical application as explained above, claims 2, 3, 5 and 6 which depend from claims 1 and 4 respectively, are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the **first paragraph** of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s), specifically claims 1 and 4 contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The limitation of **“enabling interoperability among the application systems using the baseline data schema”** and **“providing access to the application systems via the point of access using the application database and the reporting database”** was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claims 2, 3, 5 and 6, they depend from claims 1 and 4, respectively, and are rejected on the same basis.

Claim Rejections - 35 USC § 112

The following is a quotation of the **second paragraph** of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 4, the limitation, “dynamically generating a point of access user interface” is indefinite. It is not clear how the user interface is generated. Second, “enabling

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interoperability among the application systems using the baseline data schema” is indefinite. It is not clear how enabling interoperability using a data schema is achieved. Last, the limitation “point of access” is indefinite. It is not clear what the metes and bounds of point of access are and how the point of access is achieved.

Regarding claims 2, 3, 5 and 6, they depend from claims 1 and 4, respectively, and are rejected on the same basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Morgenstern (U.S. Patent No. 5,970,490).

Regarding claims 1 and 4, Morgenstern discloses a system comprising:

process of surveying a data source; (fig. 1, users 8 and 14)

capturing changes to the data source; (fig. 1, items 2, 4, 6 and col. 28, lines 52-65)

dynamically updating a point of access user interface based on the changes to the data source; (figs 1 and 2, item 10, and col. 28, lines 52-65)

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dynamically updating an application database and a reporting database based on the changes to the data source; (figs. 1 and 2, items 1, 2, 4, 6, *transformations*)

dynamically updating an interoperability engine baseline data schema based on the changes to the data source; (fig. 1, items 11, 16 and 20)

allocating space in the application database for the changes to the data source; (fig. 1 and col. 28, lines 52-65, *update*)

applying an integration unit mapping the application systems to the baseline data schema; (fig. 1, items 1, 6, 11, 12, 14 and 16)

providing access to the application systems via the point of access using the application database and the reporting database (fig. 1, items 14 and 10, *new interfaces*).

Regarding claims 2 and 5, Morgenstern discloses data source surveying is on demand (fig. 1, users 8, 12 and 14).

Regarding claims 3 and 6, Morgenstern discloses data source surveying is regularly initiated (fig. 1 and col. 28, lines 24-40).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following prior art shows the state of art with respect to data interoperability:

U.S. Patent No. 6,085,198 of Skinner et al.

U.S. Publication No. 2002/0188486 of Gil et al.

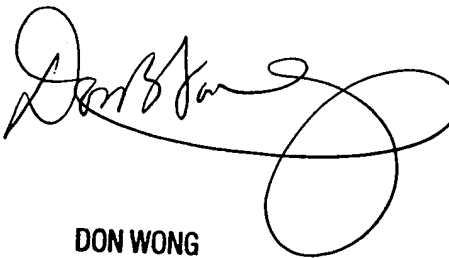
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R. Filipczyk whose telephone number is (571) 272-4019. The examiner can normally be reached on Mon-Fri, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MF
November 9, 2006



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